

Serial No.: 10/563,660
Docket No.: 09792909-6521
Amendment dated July 16, 2008
Reply to the Office Action of April 16, 2008

REMARKS

A. Introduction

Claims 1-6 are pending and under consideration in the application.

In the Office Action of April 16, 2008, the drawings were objected to and claims 1, 2, 4, and 5 were rejected as anticipated and claims 3 and 6 were rejected as obvious.

In response, the objection to the drawings and the rejection of the claims are traversed. Claims 7-10 have been added. No new matter is presented.

B. Applicant-Initiated Interview

Applicant notes with appreciation the new, non-final Office Action sent to correct the premature finality of the final office action sent January 2, 2008. The final office action provided new grounds for rejection in the form of new arguments and new passages cited in existing art of record. Given the new grounds for rejection that were not necessitated by amendment, the finality of the Office Action was premature. The Examiner corrected this defect via the present non-final Office Action. Notably, Applicant denies having made the statement that the art of record "provides adequate teaching," as erroneously alleged by the Examiner. *See* the Interview Summary dated April 16, 2008. Rather, the Applicant's position was that the Examiner's grounds for rejection in the final office action were different than the prior grounds for rejection and that a new, non-final Office Action was necessary according to proper examination procedures. *See* MPEP §706.07.

C. Information Disclosure Statement

Filed herewith is an Information Disclosure Statement (IDS) containing an English Abstract of the foreign reference not previously considered by the Examiner, i.e., JPO Pub. No. 01-283182 to Mamoru et al. The fee provided by 37 CFR 1.17(p) is submitted herewith for an IDS filed after non-final, but before final. Consideration of the IDS is requested.

D. Drawings

Regarding the Examiner's objection to the drawings, as best understood by Applicant, the Examiner appears to object to alleged inconsistent characterization of Figures 5 and 6 as "diagrams" in the Brief Description of the Drawings and "tables" in the Specification. Notably, a table is a form of a diagram, thus both characterizations are accurate. Likewise, the Examiner's characterization of the tables as "charts" is also accurate because charts can be "in tabular form" and includes "diagrams." See Merriam-Webster Dictionary.

If the objection to the Drawings is continued, Applicant requests specific authority for the objection, e.g., MPEP. As is, the objection to the Drawings is invalid as the characterizations of Figures 5 and 6 are consistent and supported by 37 CFR 1.84(d), which provides (emphasis added):

(d) Graphic forms in drawings. Chemical or mathematical formulae, tables, and waveforms may be submitted as drawings and are subject to the same requirements as drawings. Each chemical or mathematical formula must be labeled as a separate figure, using brackets when necessary, to show that information is properly integrated. Each group of waveforms must be presented as a single figure, using a common vertical axis with time extending along the horizontal axis. Each individual waveform discussed in the specification must be identified with a separate letter designation adjacent to the vertical axis.

Accordingly, Applicant requests withdrawal of the objection.

E. Rejection under 35 USC §102

Claims 1, 2, 4, and 5 have been rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Publication No. 2004/0001134 to Nakazawa. Applicant traverses these rejections for at least the following reasons.

Without conceding to the merits of the rejection, independent claims 1 and 4 have been amended to incorporate the limitations previously recited in original claims 3

and 6. Independent claims 1 and 4 now generally recite, *inter alia*, "an ink absorption amount in 100 msec of 15 mL/m² or more." The Examiner acknowledges that Nakazawa is deficient and does not disclose or suggest these limitations. In attempt to remedy the Nakazawa deficiency and reject these limitations, the Examiner argues that U.S. Patent Publication No. 2002/0097290 to Koitabashi teaches such. However, Koitabashi fails to teach these limitations and one of ordinary skill in the art would never combine Koitabashi with Nakazawa as argued by the Examiner.

The Examiner argues that one of ordinary skill in the art would be motivated to combine Koitabashi with Nakazawa "in an effort to use the most effective medium available as an improvement over the existing options at the time." See the Office Action, pg 7. However, Koitabashi is not combinable with Nakazawa for at least the reason that the Nakazawa printing device does not employ aqueous inks as does the does the Koitabashi printing device. Rather, the Nakazawa device employs oil-based ink, which does not have any absorption problems. In fact, Nakazawa is specifically designed to use oil-based ink so that "cockling of paper due to ink absorption, as with aqueous ink, does not occur, and there are fewer constraints on the recording medium." See Nakazawa, para. 55. Thus, Nakazawa specifically teaches away from Koitabashi by requiring a completely contradictory approach to the ink employed by either printing device, and therefore one of ordinary skill in the art would not have been motivated to combine these references, and no expectation of success in combining these references exist. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) (References are not properly combinable or modifiable if their intended function is destroyed).

Moreover, even if these references could be combined, such a hypothetical combination would not provide the invention as recited. The Examiner argues that Koitabashi teaches recording material with an ink absorption amount in 100mS of 15mL/m² or more. See the Office Action, pg 7. However, Koitabashi is limited to an absorption amount in 100mS of 100mL/m² or more. See the passage relied on by the examiner, Koitabashi, para. 61. Koitabashi then teaches away from any lower absorption amounts via the statement: "[I]f it is in this range, even

in the case of making multi-printings, occurrences of bleeding, repelling, and beadings can be prevented." *Id.* Clearly, Koitabashi fails to remedy the Nakazawa deficiency and independent claims 1 and 4 are patentable over these references.

Accordingly, because (1) the references do not teach or suggest all of the limitations recited in independent claims 1 and 4; (2) the references relied upon are not combinable without destroying the intended purpose of the references, and (3) there is no motivation to combine the references relied upon to result in the Applicant's invention as claimed, independent claims 1 and 4 are patentable over the references and withdrawal of these rejections and allowance of these claims are earnestly solicited. Likewise, claims 2, 3, and 5-10 depend from either independent claims 1 or 4 and thus includes all of the limitations of independent claims 1 and 4. Accordingly, dependent claims 2, 3, and 5-10 are also allowable over these references for at least the same reasons discussed above with respect to claims 1 and 4. Therefore, withdrawal of these rejections and allowance of these claims are earnestly solicited.

F. New Claims

New claims 7-10 have been added. Support for the new claims can be found in the Specification, for example, in paragraph 47. New claims 7-10 recite features, which are not disclosed, taught, or suggested in the art of record. For example, claim 9 recites, among other things, "wherein the ink absorption amount of said recording material in 100 msec is between 18 and 40 mL/m²," which is patentable over the art of record.

Accordingly, it is respectfully submitted that new claims 7-10 do not present new matter and are allowable over the prior art of record, and allowance of these claims is earnestly solicited.

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E. Conclusion

In view of the foregoing, it is submitted that claims 1-10 are allowable and that the application is in condition for allowance. Notice to that effect is requested.

If any further fees are required in connection with the filing of this amendment, please charge the same to our Deposit Account No. 19-3140.

Respectfully submitted,
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